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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,204	11/22/2000	Sam B. Morrison	05725.0642-00	9514

22852 7590 01/21/2003
FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/717,204	Applicant(s) MORRISON, SAM B.	
	Examiner Michael A. Willis	Art Unit 1617	
	-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 30 October 2002 and 01 November 2002.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1, 2 and 4-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-2, 4-31 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Applicant's amendment of 1 November 2002 is entered. Claims 1, 2, and 10 are amended. Claims 29-31 are added. Claims 1-2 and 4-31 are pending. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Applicant's election with traverse of styrene/butylene/ethylene/styrene as the species of at least one block copolymer film former in Paper No. 9 is acknowledged. Claims 1-2 and 4-31 are examined as they read on the elected species.

Terminal Disclaimer

The terminal disclaimer filed on 30 October 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 09/258,809 has been reviewed and is NOT accepted.

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because the disclaimer appears to have a typographical error in that it refers to Application No. 09/445,588, which is unrelated to the instant application, rather than Application No. 09/258,809, which is the subject of the double-patenting rejection. The double-patenting rejection of record is maintained with respect to Application No. 09/258,809. A new terminal disclaimer directed to 09/258,809 rather than 09/445,588 is required.

Response to Amendments/Arguments

The following rejections are withdrawn:

The objection to Claim 2 is withdrawn in view of amendments to the claim.

The rejection under 35 USC 102(e) over Knitowski et al (US Pat. 6,248,339) is withdrawn. Applicant's argument that butylene/ethylene/styrene is different than styrene/butylene/ethylene/styrene, and that butylene/ethylene/styrene does not meet the limitation of a tri-block copolymer is convincing.

The rejection of claims 1, 6-10, 16, 22-24, and 27-28 under 35 USC 102(b) over DesLauriers et al (US Pat. 5,221,534) is withdrawn in view of amendments to include weight percentages and applicant's argument with respect to "picking and choosing" for additional components.

The following rejection is maintained:

Claims 1-2, and 4-31 are rejected under 35 USC 103(a) as being unpatentable over DesLauriers et al (US Pat. 5,221,534) in view of Anton (US Pat. 6,066,313), Konik (US Pat. 6,060,072), or Kimura (US Pat. 4,528,390) for reasons as stated previously.

Applicant argues that DesLauriers does not individually teach all of the limitations of the claims. Specifically, applicant argues that the compositions of Table 11 of the reference contain at least 2.5% by weight of block copolymer. Applicant further argues that, based on deficiencies in the data in Table 11, one of ordinary skill in the art would not have been motivated to decrease the concentration of block copolymer to an

amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition. Additionally, applicant argues that the data of Table 11 teaches away from the use of more than 2% dimethicone to arrive at compositions comprising 25-75% linear dimethicone as in claim 31.

Applicant's argument is not convincing for several reasons. First of all, it is noted that claims 27-31 do not require a weight percentage range of block copolymer. Secondly, with respect to claims 1-2 and 4-26, which require a weight percentage range of block copolymer or claim 31, which requires a weight percentage range of linear dimethicone, the exact weight percentages of Table 11 are not considered by the examiner to limit the subsequent formulation of compositions according to the teachings of DesLauriers. When considering the teachings of DesLauriers **as a whole**, the compositions in Table 11 are not meant to represent final formulations, but rather are meant to show the compatibility of a gel according to the teachings of DesLauriers with common cosmetic ingredients (see col. 13, lines 13-15). It is not clear from the data in Table 11 whether compositions comprising more than 2% dimethicone were tested and resulted in separation, or were simply not tested. Irrespective of the deficiencies of Table 11, DesLauriers clearly teaches the use of block copolymer blends including triblock copolymers in forming gels where the total amount of block copolymer ranges down to 1% of the composition (see col. 6, lines 3-36; see also claims 1 and 10). The amounts of the copolymers in the gel "will determine the final form of the gel" ranging from fragile gels through flexible gels to firm gels (see col. 6, lines 45-54), providing clear motivation to one of ordinary skill in the art to vary the amount of copolymer in the

compositions. Furthermore, DesLauriers clearly teaches that solvents may be used to dilute the resulting gel in order to formulate lotions or other flowable compositions (see col. 6, lines 34-44). Such solvents used to dilute the gel include silicones (see col. 6, lines 34-44; and claims 1 and 5). Combined with actual data from Table 11 showing compatibility between such gels and dimethicone, it would have been obvious to vary the weight percentages of various components in the final formulation of products.

Differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

With respect to new claim 29, applicant argues that DesLauriers does not suggest the combination of both linear dimethicone and cyclic dimethicone. Applicant further argues that one would not be motivated to combine these ingredients, since "they are disclosed to be the worst emollients in terms of sample separation". However, the data in Table 17 does not support an assertion that cyclomethicones have worse properties than other solvents. On the contrary, cyclomethicone is given positive ratings in both viscosity and esthetics, where Drakeol 35 and Finsolve TN achieve positive ratings in only one category each (see col. 17, lines 8-20). With respect to dimethicone and the data in Table 11, disclosed examples and preferred embodiments do not constitute a teaching which is away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 169 USPQ 423 (CCPA 1971). "A known or obvious

composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Rather than excluding or teaching away from any of the tested components in Table 11 for purposes of formulating commercial products, the teachings of DesLauriers are understood by the examiner as teaching that the block copolymer gels are positively compatible with a wide variety of cosmetic components, including dimethicone. As for the combination of both a linear dimethicone and a cyclic dimethicone, the examiner concedes that DesLauriers does not have an actual example comprising both components together. However, such combinations are clearly taught by Anton '313, which teaches cosmetic sticks preferably comprising 10-40% cyclomethicone and 10-30% dimethicone (see col. 9, lines 45-63; and claim 7).

Applicant argues that the rejection of claims 27 and 28 requires "picking and choosing" by the Examiner to arrive at the claimed compositions. Applicant argues that DesLauriers recites a variety of cosmetic uses while only mentioning dimethicone once in the context of Table 11. Applicant further asserts that the data in Table 11 shows dimethicone to be the worst of the tested emollients. The argument is not convincing in light of claim 5, which specifically claims silicones. Since the only examples of silicones presented by DesLauriers are dimethicone and cyclomethicone, one of ordinary skill in the art would be especially pointed in the direction of those two components as preferred species of silicones by the teachings of DesLauriers. Furthermore, the data in Table 11 is not seen as limiting the formulation of compositions by one of ordinary skill in the art. The test for obviousness is not whether the features of a secondary reference

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may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). DesLauriers clearly teaches that "the composition of the invention has wide applications in various health and beauty aid compositions", and specifically mentions lipstick (see col. 7, lines 38-45). Claim 5 of DesLauriers is directed to silicones, with actual data pointing to compatibility of the gels with dimethicone. Anton '313 teaches lipsticks comprising 10-30% dimethicone. With respect to the additional film former of claim 30, such limitation is met by Kraton 1702 of Table 11 of DesLauriers, for example.

Therefore, the instant claims are rendered obvious by the combination of references cited above.

The following new grounds of rejection are made:

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is confusing due to the limitation of "wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition". The phrase is confusing because the limitation is unclear in the case where more than one block copolymer film former is

present. Specifically, it is unclear whether the total amount of a mixture of block copolymer film formers must be within the stated range, or whether the weight percentage of each individual block copolymer film former must be within the stated range.

Claim 10 is confusing and lacks antecedent basis for the recited range of "0.139% to 4.185% by weight" because such range is outside the range of claim 1 from which it depends.

Any remaining claims are rejected for depending from indefinite base claims.

Claim 30 is rejected under 35 USC 102(b) as being clearly anticipated by DesLauriers et al (US Pat. 5,221,534). Applicant argues that the reference does not describe the claimed composition without the need for picking and choosing. Applicant's argument is not convincing. The instant claim is directed to a composition comprising a linear dimethicone, a tri-block copolymer film former, and an additional film former. Table 11 of DesLauriers describes a composition comprising dimethicone, Kraton 1702 (meeting the limitation of an additional film former), and Kraton 1650 (meeting the limitation of a tri-block copolymer film former) (see col. 10, lines 1-45; col. 13, lines 10-40). The limitation of "an additional film former" includes components that may also be considered as block copolymer film formers, such as Kraton 1702.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

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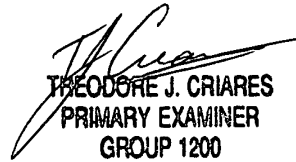
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
January 15, 2003



THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200